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06/331,042	12/16/81	JONES C	X-5526A

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EXAMINER	
SCHWARTZ, R	
ART UNIT	**PAPER NUMBER**
121	8

DATE MAILED: 12/22/82

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined. ☑ Responsive to communication filed on 11-15-82 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892
2. ☐ Notice of Informal Patent Drawing, PTO-948
3. ☑ Notice of References Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 1-62 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☑ Claims 1-62 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ The formal drawings filed on _____ are acceptable.

8. ☐ The drawing correction request filed on _____ has been ☐ approved. ☐ disapproved.

9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
   ☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____,
   filed on _____.

10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

11. ☐ Other

PTOL-326 (rev. 7-79)

EXAMINER'S ACTION

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 11, 12, 14 and 17-62 are rejected under 35 U.S.C. 103 as being unpatentable over Jones for reasons of record.

Applicant's arguments filed November 15, 1982 and the five declarations under 37 CFR 1.132 have been fully considered but they are not deemed to be persuasive.

In order to show the criticality of substituent selection from the prior art genus, the prior art utility must be included in a showing. Only the Clemens declaration deals with the prior art utility, and said declaration fails to include the number of animals tested.

35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 24-47 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

The claims are based on beliefs and expectations arising from the test data (see page 87, for example). Curing of cancer must be based on more substantial data. Prostatic cancer and breast cancer lack significance because different forms of cancer may affect these regions.

Claims 48-62 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Failure to include an amount of active ingredient renders the claims indefinite and readable on toxic and ineffective dosages.

Claims 8-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

The claims are improperly dependent on a species claim , e.g., there is no R^2 group in claim 1.

Schwartz:jag
A/C 703
557-2517
12-20-82

RICHARD A. SCHWARTZ
PRIMARY EXAMINER
ART UNIT 121